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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/534,494	03/24/2000	Jung-Kwon Heo	1293.1100/MDS	2442

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EXAMINER

CHEVALIER, ROBERT

ART UNIT	PAPER NUMBER
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2615

DATE MAILED: 02/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/534,494

Applicant(s)

HEO ET AL.

Examiner

Bob Chevalier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 March 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6-9.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-6, 10-12, 20-21, 28, and 30-32, are rejected under 35 U.S.C. 102(b) as being anticipated by Yonemitsu et al.

Yonemitsu et al discloses an optical disc recording/reproducing apparatus that shows all the limitations recited in claims 1, 20, and 31, including the feature of the lead-in area, lead-out area, and the user area having a compact disc format and being distinguished from each other on the physical layer of the disc (See Yonemitsu et al's Figures 3-7), and the feature of the information having a DVD application format according to a predetermined file system being recorded in the user area as specified in the present claims 1, 20, and 31. (See Yonemitsu et al's Figure 13, and see Yonemitsu et al's column 5, lines 43-54, and column 18, lines 10-16).

With regard to claims 2-3, 5-6, and 11-12, the feature of the file system being a universal disc format bridge format as specified thereof would be present in Yonemitsu et al. (See Yonemitsu et al's column 5, lines 43-54, and column 18, lines 10-16).

With regard to claims 4, 10, 21, 28, and 32, the feature of encoding received A/V signal into a DVD format and formatting the same according to a file system for DVD application as specified thereof would be present in Yonemitsu et al. Because, Yonemitsu et al discloses that file data recorded in the user area or program area of the

disc can be in a DVD format and that application information is further recorded on the disc for the purpose of facilitating identification and reproduction of said recorded DVD signals. (See Yonemitsu et al's Figure 13, and column 33, lines 46-56, and furthermore, see Yonemitsu et al's Figure 32, and 1). And furthermore, the feature of formatting the data for the lead-in and lead-out areas in the CD-ROM format and recording the same thereof as specified in the present claims 4, 10, 21, 28, and 31, would also be present in the Yonemitsu et al. (See Yonemitsu et al's Figures 3-7, and column 5, lines 43-45, and column 29, lines 23-24).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 7-9, 13-15, 16-19, 22-27, and 29, are rejected under 35 U.S.C. 103(a) as being unpatentable over Yonemitsu et al in view of the admitted prior art Figure 1 of the present Application.

Yonemitsu et al discloses disc recording/reproducing apparatus that shows substantially the same limitations recited in claims 7-8, 13-14, 22-23, 25, and 29, including the feature of the file system including the capability of deformatting the DVD application written in a user area and decoding and deformatting to restore A/V signal as specified in the present claims 7-8, 13-14, 22-23, 25, and 29. (See Yonemitsu et al's Figure 13, and column 33, lines 46-56, and furthermore, see Yonemitsu et al's Figure 32, and 1).

Yonemitsu et al fails to specifically disclose the feature of the differentiator to determine whether the disc is a video CD or an audio CD so as to deformat and decode the A/V signal in order to output the A/V signal as specified in the present claims 7-8, 13-14, 22-23, 25, and 29.

The admitted prior art, Figure 1 of the present Application, discloses such a feature of the disc recording/reproducing apparatus which includes the feature of the differentiator to determine whether the disc is a video CD or an audio CD so as to deformat and decode the A/V signal in order to output the A/V signal as specified in the present claims 7-8, 13-14, 22-23, 25, and 29. (See admitted prior art Figure 1 of the present Application).

It would have been obvious to one skilled in the art to modify the Yonemitsu et al's recording/reproducing apparatus wherein the recording means provided thereof

would incorporate the capability of the differentiator to determine whether the inserted disc is a video CD or an audio CD so as to deformat and decode the A/V signal in order to output the A/V signal in the same conventional manner as is shown in the admitted prior art of the present Application. The motivation is to increase the accessing speed of the recorded data during reproduction operation as suggested in the prior art.

With regard to claims 9, 16-17, 24, and 26, the feature of deformatting and decoding the DVD application to restore the A/V signal if it is determined that a predetermined file system exists, and deformatting and decoding a CD application if it is determined that the disc is a video disc or an audio disc to restore the A/V signal as specified thereof is noted to be inherently present in the proposed combination of Yonemitsu et al and the admitted prior art, Figure 1 of the present Application. Because, Yonemitsu discloses that the optical disk can be used as CD or DVD since the optical disk would have recorded thereon both audio information and video information at different recording formats (See Yonemitsu et al's column 2, lines 48-56), and furthermore, Yonemitsu et al discloses that the reproducing apparatus detects the format of the information recorded on the optical disk so as to permit proper interpretation of the played back data consistent with the sensed data structure. (See Yonemitsu et al's column 13, lines 39-42). And furthermore, the feature of checking the physical structure of the disc to determine whether the disc is a DVD or a CD as specified in the present claims 9, 16-17, 24, and 26, is present in the proposed combination indicated above. (See Yonemitsu et al's column 13, lines 39-47, where it is disclosed that disk type is determined).

With regard to claims 15, 18-19, and 27, the feature of determining whether the disc is an audio CD by analyzing control information in a sub-Q area of the lead-in area of the disc; and determining whether the disc is a video CD by analyzing top of contents information as specified in the present claim would be present in the proposed combination of Yonemitsu et al and the admitted prior art Figure 1 of the present Application. (See the admitted prior art Figure 1 of the present Application).

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of copending Application No. 09/534493. Although the conflicting claims are not identical, and that the claimed language of the present Application is somewhat different from the language recited in the claims 1-29 of the copending Application 09/534493, however, they are not patentably distinct from each other because it is noted that it would have been obvious to one of ordinary skill in the art to recognize that the claims 1-29 of the

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compending Application would be able to perform the functions of the claimed limitations of the present Application since the limitations recited in the claimed invention of the present Application are also recited in the patented claims. Particularly, the claimed feature of the present Application of recording in a user area of a CD-type disc information having a DVD application format, and the claimed feature of the present Application of the CD-type disc having a lead-in, lead-out, and a user area having a CD-ROM format, are noted to be present in the compending Application. (See, for example, claim 1 of the compending Application). And furthermore, the claimed feature of the present Application of determining whether the CD is video CD, an audio CD, or a DVD and performing recording and reproduction accordingly is also noted to be present in the compending Application. (See, for example, claims 9, and 10, of the compending Application).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kamatani discloses a multi-standard optical disc.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bob Chevalier whose telephone number is 703-305-4780. The examiner can normally be reached on MM-F (9:00-6:30), second Monday off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Christensen can be reached on 703-308-9644. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

B. Chevalier
February 5, 2004.


ROBERT CHEVALIER
PRIMARY EXAMINER